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In re Application of
DUBOIS
Application No.: 09/202,217
PCT No.: PCT/FR97/01023
Int. Filing Date: 10 June 1997
Priority Date: 11 June 1996
Attorney's Docket No.: 146.1307
For: NEW DEVICES INTENDED FOR THE
TRANSDERMIC ADMINISTRATION OF
TRIMEGESTONE, THEIR PREPARATION
PROCESS AND THEIR USE AS MEDICAMENTS

DECISION ON
RENEWED PETITION
UNDER 37 CFR 1.47(b)

This decision is in response to applicant's "RENEWED PETITION UNDER 37 CFR 1.47(b)" filed 08 February 2002.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01023, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 09 December 1998, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee.

On 21 September 1999, applicant filed a PETITION UNDER RULE 42. The petition was accompanied by: the petition fee; a declaration of Jean-Claude Vieillefosse setting forth facts entitled DECLARATION UNDER RULE 47 (hereinafter "first declaration of facts"); a declaration of Mr. Vieillefosse on behalf of and as agent for the non-signing inventor; and Exhibits A-F:

- Exhibit A, a declaration of designation of inventors signed by Mr. Dubois;
- Exhibit B, copy of French law;

- Exhibit C, copy of employment contract;
- Exhibit D, copy of letter written to Mr. Dubois on 09 November 1998;
- Exhibit E, copy of fax to Mr. Dubois sent on 02 December 1998; and
- Exhibit F, copy of letter forwarded to Mr. Dubois on 30 December 1998.

However, Exhibits A and D-F were not in the application file. Additionally, the listing of "Enclosures" in the petition did not include the documents corresponding to Exhibits A and D-F.

On 27 October 1999, the USPTO mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 04 November 1999, applicant filed a RESPONSE to the NOTIFICATION OF MISSING REQUIREMENTS stating that a petition under Rule 42 was filed on 21 September 1999. The RESPONSE included a postcard receipt. Note that this postcard receipt did not list the items which comprised Exhibits A and D-F.

On 09 March 2000, the USPTO mailed a decision indicating that the petition under 37 CFR 1.42 was dismissed because an oath or declaration by the legal representative of the deceased inventor had not been presented. The decision also discussed the petition and supporting documentation as it related to 37 CFR 1.47(b) for petitioner's information only.

On 06 April 2000, applicant filed a RENEWED PETITION UNDER 37 CFR 1.47(b). The renewed petition was accompanied by a second declaration of facts (hereinafter "second declaration of facts") by Jean-Claude Vieillefosse and purportedly Exhibits A and D-F, which were missing from the submission of 21 September 1999. The sheet marked Exhibit A, however, is not a declaration of designation of inventors signed by Mr. Dubois but is rather an attestation certifying that Mr. Dubois was an employee of Hoechst Marion Roussel from 02 September 1985 to 31 December 1997. (It is also noted that Exhibits D and E were mislabeled.) English translations of Exhibits D-F were also provided. The renewed petition was also accompanied by an "Extract from the minutes of the Board of Executive Directors' deliberations dated Thursday 10 December 1998 at 2:00PM" and an English translation thereof.

On 27 July 2000, the USPTO mailed a decision dismissing applicants renewed petition under 37 CFR 1.47(b). Specifically, it was noted that factual proof that the inventor refuses to execute the application and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 14 June 2001, applicant submitted a facsimile transmission, which was treated as a petition under 37 CFR 1.181. The petition requested that the documents including, *inter alia*, the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)" submitted with the petition under 37 CFR 1.181 be accepted as having been filed with the USPTO on 18 December 2000. The submission

was accompanied by, *inter alia*, a copy of the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)"; a copy of a request for a three-month extension of time; a copy of a credit card payment form authorizing the fee for a three-month extension of time; a third declaration of facts from Jean Claude Vieillefosse; and a copy of a date-stamped postcard receipt.

On 02 July 2001, the USPTO mailed a decision granting applicant's petition under 37 CFR 1.181 and dismissing applicant's renewed petition under 37 CFR 1.47. Specifically, it was noted that factual proof that the inventor refuses to execute the application and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 23 July 2001, applicant submitted a third renewed petition under 37 CFR 1.47(b).

On 14 December 2001, the USPTO mailed a decision dismissing applicant's renewed petition under 37 CFR 1.47. Specifically, it was noted that factual proof that the inventor refuses to execute the application and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application still had not been provided.

On 08 February 2002, applicant submitted a fourth renewed petition under 37 CFR 1.47(b), which was accompanied by a fourth declaration of facts from Jean-Claude Vieillefosse.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. As indicated in the decision mailed 27 July 2000, applicants have satisfied items (1), (3), (4), and (6) above.

In regard to item (2), as indicated in the decision mailed 14 December 2001, the oral refusal (22 December 1998) referred to in the third declaration of Jean-Claude Vieillefosse was made before Mr. Dubois was presented with the application papers (30 December 1998) (see first declaration of facts of Mr. Vieillefosse, bottom of page 2). Additionally, it has not been established that Mr. Dubois failed to respond to the application papers sent to him on 30 December 1998. The renewed petition filed 23 July 2001 urges that the application papers were originally submitted to Mr. Dubois on November 9, 1998 with Miss Louvet's letter of that date. However, there is nothing in the translation of that letter which suggests that the application papers were sent on that date. The renewed petition filed 08 February 2002 does not address this issue.

Regarding item (5), the decision mailed 14 December 2001 indicated that it had not been

established that the employee was performing an inventive task which corresponded to his actual duties or was performing studies and research with which he had been explicitly entrusted. Applicant has provided another declaration of facts by Jean-Claude Vieillefosse. However, this declaration of facts is insufficient. First, it is noted that it contains apparently incorrect information. For example, this declaration of facts states that Jean-Claude Vieillefosse "was head of the [Patent Department of Aventis Pharma S.A.] during the time that Jean-Luc Dubois was employed by Aventis Pharma". However, there is no evidence that Jean-Luc Dubois was ever employed by Aventis Pharma. Second, there is no evidence that Aventis Pharma is the 37 CFR 1.47(b) applicant. Third, even assuming *arguendo* that the declaration did not suffer from these first two problems, the declaration does not appear to be made by a person having firsthand knowledge of the facts that the employee was performing an inventive task which corresponds to his actual duties or was performing studies and research with which he had been explicitly entrusted. For example, the declaration states that Mr. Vieillefosse "received the invention disclosure for the present application submitted by Jean-Luc Dubois as a result of his research duties in accordance with his employment contract." While Mr. Vieillefosse may have firsthand knowledge that he received this invention disclosure, it is not clear that he has firsthand knowledge that the employee was performing an inventive task which corresponds to his actual duties or was performing studies and research with which he had been explicitly entrusted. For example, it is not clear how Mr. Vieillefosse would have firsthand knowledge of Mr. Dubois's "research duties." Thus, it is not clear how Mr. Vieillefosse would have firsthand knowledge of whether what was described in the invention disclosure corresponded to Mr. Dubois' actual duties or to studies and research with which Mr. Dubois had been explicitly entrusted.

Attention is directed to MPEP § 409.03(f) for information regarding proof of proprietary interest.

Also regarding item (5), the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor in the declaration submitted 21 September 1999 is Hoechst Marion Roussel. However, the employment contract of Mr. Dubois is with Roussel Uclaf. While it has been stated that Hoechst Marion Roussel is the successor to Roussel Uclaf (e.g., page 2 of "RENEWED PETITION UNDER 37 CFR 1.47(b)" filed 18 December 2000 and page 1 of the declaration of facts by Jean-Claude Vieillefosse filed 18 December 2000), the precise relationship (e.g., company name change, merger, etc.) between the companies has not been provided. The precise relationship between Roussel Uclaf and Hoechst Marion Roussel must be explained and proof of the relationship must be provided. If the 37 CFR 1.47(b) applicant is now Aventis Pharma, the precise relationship between it, Hoechst Marion Roussel and Roussel Uclaf must be explained and proof of the relationship must be provided. Also, if the 37 CFR 1.47(b) applicant is now Aventis Pharma, a new declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor would likely be required.

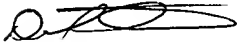
CONCLUSION

For the above reasons, applicants' renewed petition under 37 CFR 1.47(b) is **DISMISSED**,

without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". Extensions of time may be obtained under 37 CFR 1.136(a). No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



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